

Docket No. F-8019

Ser. No. 10/699,136

REMARKS

Applicant has amended the claims to further distinguish over the art and provides the following traverse of the outstanding rejections.

In the Office Action of March 16, 2005, claims 1 and 3-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sameshima (JP01-028625) as modified by Barry (U.S. Patent No. 4,724,007) where Barry is cited for teaching cleaning a heat exchanger. Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sameshima as modified by Barry and as further modified by Withers Jr (U.S. Patent No. 4,007,774) where Withers is cited for teaching reverse-flow.

In the outstanding Office Action, claims 1 and 3-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barry as modified by Sameshima and Withers, where Sameshima is cited for teaching a suction pipe and a waste water collecting tank and Withers is cited for teaching reverse-flow.

Furthermore, in the Amendment filed on June 16, 2005, Applicant argued that Sameshima, at page 2, last paragraph, specifically teaches away from cleaning pipes in the reverse direction of flow. Accordingly, Applicant argued that it would be improper to modify Sameshima by Withers to provide for cleaning pipes in the reverse direction as recited in the independent claims. Applicant also argued that Sameshima, in the same text, teaches away from cleaning pipes with the application of water jets. Accordingly, Applicant argued that it would be improper

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to modify Sameshima by Barry because Barry teaches cleaning pipes with water projectile launchers (similar to jets) and thus, as a whole, Barry contradicts Sameshima.

In the outstanding Office Action, the Examiner states "Sameshima does not teach against water jets and reverse flow. Sameshima teaches that it is not advisable with respect to the particular application [of Sameshima]. Sameshima does not suggest that the process of water jets and reverse-flow would not work for other applications."

Applicant respectfully traverses the rejections as follows.

Regarding the Examiner's comments related to Sameshima, Applicant has an invention disclosed in a reference cannot be modified to render the invention unsatisfactory for its intended purpose (*In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (a proposed modification to a reference cannot render the reference unsatisfactory for its intended purpose)). Furthermore, when combining references, the references must be considered in their entirety, including portions which lead away from the claimed invention (*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983) (a "reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention"))). It is not relevant that the modification would leave the reference in a satisfactory condition for "other applications" or to reject the claims of an invention. On the contrary, it is improper for the Examiner

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to discount the specific teachings of the cited references by applying the Examiner's knowledge gained from the invention's disclosure to reject the claims (a.k.a., improper hindsight reasoning). *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (requiring the Examiner to provide references that both teach the limitations in the claims and suggest combining their respective teachings "stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness").

Furthermore, regarding the rejections of the claims, Barry (now the main reference) teaches a launcher for launching pigs into a pipe for cleaning the pipe. Modifying Barry to provide a cleaning system which uses suctioning to draw ice through pipes would change the principle operation of Barry and is improper. *In re Ratto*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959) (references cannot be combined so as to change a principle of operation of the primary reference). Accordingly, the suggested modification of Barry by the cited references or any prior art reference is improper.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

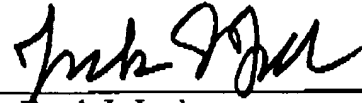
The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

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Respectfully submitted,
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